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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/128,450 09/28/93 HEUER

L BAYER8890LHL

EXAMINER ROBINSON, A

12M2/0215

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ART UNIT	PAPER NUMBER
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1209

DATE MAILED: 02/15/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449. (1 sheet)
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ _____

Part II SUMMARY OF ACTION

- ☒ Claims 1-6 are pending in the application.
Of the above, claims 4 and 5 are withdrawn from consideration.
- ☐ Claims _____ have been cancelled.
- ☐ Claims _____ are allowed.
- ☒ Claims 1-3 and 6 are rejected.
- ☐ Claims _____ are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
- ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☒ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

Art Unit 1209

Restriction to one of the following distinct and independent inventions was required in a telephone conversation of January 26, 1994, between Mr. Horn and Examiner Robinson, with Mr. Horn electing with traverse the invention of Group I. (35 USC 121 and 37 CFR 1.142).

I. Claims 1-3 and 6^{are} drawn to compositions and method of protecting materials employing cyproconazole which is classified in 514/383.

II. Claims 4 and 5 are drawn to microbicidal compositions employing cyproconazole with a multitude of known antimicrobially fungicidally and/or insecticidally active compounds which are classified in a variety of subclasses in Class 514.

The several inventions above are independent and distinct, each from the other, as they have acquired a separate status in the art as a separate subject for inventive effort, require independent searches and are separately classified. The active ingredients of the group II will fall into any number of subclasses depending upon the specific active material. It is noted that one specific synergistic combination of compounds is known to be chemically distinct from another specific synergistic combination of compounds, and reference to one combination would not be a reference against the other combination under 35 USC 103. (See page 9 of the specification).

Art Unit 1209

Further, all of the claims of Group II read on a multitude of combination of compounds which would require many fields of search that would be an undue burden to the examiner. Therefore, restriction for examination purposes is deemed proper.

Claims 4 and 5 are withdrawn from further consideration as being drawn to the non-elected inventions.

Claims 1-3 and 6 are acted upon as their merits.

Claims 1, 2, 3 and 6 are rejected under 35 U.S.C. § 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expressions "Use of" (claim 1), and "use according to" (claim 2) are non-descript in character and should be canceled. Claims 1-3 and ^c₆ are too broad and indefinite in failing to set forth relative proportions for all ingredients and/or amounts of active composition employed. Claims 1-3 are indefinite, vague and incomplete in that a composition is claimed but only the active ingredient is recited. Claim 6 is indefinite, vague and incomplete in failing to set forth what the "industrial materials" are protected against. The term "characterized" (claims 2 and 6) is functional and should be canceled.

Art Unit 1209

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 3 and 6 are rejected under 35 U.S.C. § 102(a) as being clearly anticipated by European Patent 0,555,186 (Am) or German Patent 4,203,090 (L).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 3 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Schaub.

The claims recite the claimed compound per se.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Art Unit 1209

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 1-3 and 6 are rejected under 35 U.S.C. § 103 as being unpatentable over Schaub (A).

The Schaub reference teaches that cyproconazole is an old fungicide employed with carriers of the type claimed. The Schaub reference also discloses that the claimed azole is effective against fungi in the same class. See col. 5, lines 52-53. Therefore, one skilled in this art would find ample motivation from the prior art supra to use cyproconazole as a fungicide against the target fungi on weed of the instant application with a reasonable expectation that said cyproconazole would be effective to combat said target fungi especially since said cyproconazole is an old fungicide. In view of the above prior art the instant claims are deemed unpatentable.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or 305-3592.

ROBINSON:jd
February 08, 1994

ALLEN J. ROBINSON
PRIMARY EXAMINER
GROUP 120